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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,696	12/20/2001	Missy L. Villapudua	020375-003100US	4166

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EXAMINER
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WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/027,696

Applicant(s)

VILLAPUDUA, MISSY L.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

- 1) The cancellation of claims 11 and 12 are acknowledged.
- 2) Applicant's arguments, with respect to rejections under 35 U.S.C. 112, filed June 03, 2003 have been fully considered and they are persuasive.

#### Rejections under 35 U.S.C. 103:

Applicant's arguments regarding rejections under U.S.C. 103 have been fully considered but they are not persuasive.

- In response to applicant's argument that Althoff et al. and Pollin do not disclose a privacy preference on a payment instrument, Althoff et al. teaches that the smart card (51) can store and manage certain secure information (paragraph [0051] – [0053]).

Pollin is combined with Netbank to store the preference data onto the check's printed MICR as well known payment instrument.

- 3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

- 4) Claims 1-2, 4-10, 13-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Privacy at Netbank (hereinafter "Netbank"; available at [www.netbank.com/security\\_privacy.htm](http://www.netbank.com/security_privacy.htm)) in view of Althoff et al. (US 2003/0018587).

#### **W.R.T. Claim 1:**

Netbank discloses a method for protecting consumer personal data, comprising:

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receiving an application for a payment instrument (e.g. credit card application, ATM card application), wherein the application comprises personal data (see generally the whole policy, wherein the customer provides a personal information) and a privacy preference of a consumer (see generally the whole policy, wherein the customer can limit or consent the bank's sharing of nonpublic personal information, i.e. the privacy preference); and

saving the application in a database (every financial institution **must** have the computer system with network ability and data storage).

However, Netbank does not expressly disclose the method of storing at least some of the personal data and the privacy preference onto the payment instrument.

Althoff et al. teaches, for a system and method for protecting consumer personal data, that the method comprises:

storing at least some of the personal data and the privacy preference onto the payment instrument, a smart card (51) with a memory or magnetic stripe (paragraph [0051] – [0053]).

Since Netbank and Althoff et al. are both from the same field of endeavor of protecting the consumer personal data over the financial transaction, the purpose disclosed by Althoff et al. would have been well recognized in the pertinent field of Netbank.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to store at least some of the personal data and the privacy preference onto the payment instrument, as taught by Althoff et al., for the purpose of producing a secure, card present equivalent interchanges with the verified customer data stored securely onto the payment instrument while providing privacy control with the customer.

**W.R.T. Claims 2 and 4-10:**

Netbank also discloses the method comprising:

mailing marketing material to the consumer only if permitted by the consumer's privacy preference (see the Policy);

wherein the privacy preference indicates that consumer receives marketing material only from affiliated merchants (*Id.*);

wherein the privacy preference indicates that consumer receives marketing material only from the affiliated bank (*Id.*); and

wherein the privacy preference indicates that the consumer opts out (see supra Policy).

However, Netbank does not specifically disclose the step of storing the personal data and privacy preference onto the payment instrument;

wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory; and

reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location.

Althoff et al. teaches, for a system and method for protecting consumer personal data, that the method comprises:

reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location (see Figs. 1 and 4A), wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (see Background and see Fig. 3).

Since Netbank and Althoff et al. are both from the same field of endeavor of protecting the consumer personal data over the financial transaction, the purpose disclosed by Althoff et al. would have been well recognized in the pertinent field of Netbank.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to utilize the credit or debit card having a magnetic stripe, or a processor and memory as the well known payment instrument; to read the personal data and the preference at a merchant location when the consumer's payment instrument is accessed; and to save the data at the merchant storage location, as taught by Althoff et al., for the purpose of storing and managing certain secure

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information and providing verified user information to merchants during the transaction to complete the "card present" transaction.

**W.R.T. Claim 13:**

Netbank discloses a method for protecting consumer personal data, comprising: receiving an application for a payment instrument (e.g. credit card application, ATM card application), wherein the application comprises personal data (see generally the whole policy, wherein the customer provides a personal information) and a privacy preference of a consumer (see generally the whole policy, wherein the customer can limit or consent the bank's sharing of nonpublic personal information, i.e. the privacy preference);

saving the application in a database (every financial institution **must** have the computer system with network ability and data storage);

providing the consumer with a payment instrument (credit card, ATM card and check); and

contacting the consumer in accordance with the privacy preference (mailing marketing material to the consumer only if permitted by the consumer's privacy preference (see the Policy)).

However, However, Netbank does not expressly disclose the method of:

storing at least some of the personal data and the privacy preference onto the payment instrument; and

reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location.

Althoff et al. teaches, for a system and method for protecting consumer personal data, that the method comprises:

storing at least some of the personal data and the privacy preference onto the payment instrument, a smart card (51) with a memory or magnetic stripe (paragraph [0051] – [0053]); and

reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location (see Figs. 1 and 4A).

Since Netbank and Althoff et al. are both from the same field of endeavor of protecting the consumer personal data over the financial transaction, the purpose disclosed by Althoff et al. would have been well recognized in the pertinent field of Netbank.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to store at least some of the personal data and the privacy preference onto the payment instrument, and to read the personal data and the preference at a merchant location when the consumer's payment instrument is



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accessed; and to save the data at the merchant storage location, as taught by Althoff et al., for the purpose of producing a secure, card present equivalent interchanges with the verified customer data stored securely onto the payment instrument while providing privacy control with the customer, and storing and managing certain secure information and providing verified user information to merchants during the transaction to complete the "card present" transaction.

**W.R.T. Claims 14 and 16:**

The modified Netbank discloses the limitations of Claims 14 and 16 in accordance with the same reason set forth in Claims 2 and 4-10.

5) Claims 1 and 3, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Netbank in view of Pollin (US 5,727,249).

Netbank discloses the method for protecting consumer personal data as recited above, but does not specifically disclose the method of storing at least some of the personal data and the privacy preference onto the payment instrument (check).

Pollin teaches, for a system and method for protecting the consumer personal data, that the method comprises:

utilizing the check as the payment instrument; and

storing the secure information onto the printed MICR on the check.

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Since Pollin and Netbank are both from the same field of endeavor, the purpose disclosed by Pollin would have been well recognized in the pertinent field of Netbank.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to utilize the check as the well known payment instrument, as taught by Pollin, for the purpose of storing the preference data onto the check's printed MICR as well known payment instrument.

6) Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Netbank and Althoff et al. as applied to the Claim 13 above, and further in view of Pollin.

The modified method of Netbank discloses the invention as recited earlier, but does not expressly disclose that the payment instrument comprises a check with the privacy preference printed on.

Pollin teaches, for a system and method for protecting the consumer personal data, that the method comprises:

utilizing the check as the payment instrument; and

storing the secure information onto the printed MICR on the check.

Since Pollin and the modified Netbank are both from the same field of endeavor, the purpose disclosed by Pollin would have been well recognized in the pertinent field of the modified Netbank.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to utilize the check as the well known payment

instrument, as taught by Pollin, for the purpose of storing the preference data onto the check's printed MICR as well known payment instrument.

### ***Conclusion***

7) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

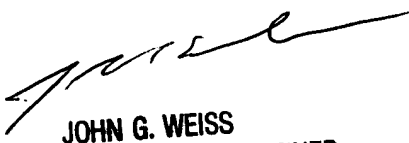
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo  
GAU 3629  
August 21, 2003



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
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